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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,236	04/10/2001	Edgar V. Menezes	INT-94	8977

7590

03/03/2003

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 03/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/832,236		MENEZES, EDGAR V.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Jordan M. Schwartz		2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 6-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group Ia, claims 1-5 in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

The specification is objected to for the following reasons;

1. In the "Brief Description of the Drawings", on page 2, line 11, it states, "Fig is an illustration..." but no Figure number is set forth. It is assumed to mean, "Figure 1 is an illustration..." and correction is required;
2. The "Brief Description" of Figure 4a is set forth twice (page 2, lines 20-21) and no "Brief Description" of Figure 4b is set forth. Correction is required

### ***Claim Rejections - 35 USC § 112***

Claim 1 (and dependent claims 2-5) is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specifically, claim 1 states that the "normalized lens distortion is less than about 300", however, applicant has not defined "normalized lens distortion" within the claim or specification in an enabling manner. Specifically, on page 4, it is stated that "normalized lens distortion" for a progressive addition lens can be defined by equation "I" and further

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that the term " $A_i$ " within equation "I" is defined by condition "II" (on page 5). However, condition "II" fails to define what is meant by the term " $C_L$ " thereby rendering condition "II", and therefore condition "I", and therefore the meaning of the term "normalized lens distortion" as lacking enablement. Claim 1 further lacks enablement because applicant is claiming a localized lens distortion "less than about 300" but has not included the units and clarification is not provided within the specification. Apparently, in equation "I", while the diopter units cancel each other out ( $M_A/3A_p$ ), the second part of the equation is in terms of lens area and widths but no units are set forth. From what is set forth in the tables, the units of the second part of equation "I" are apparently in "mm" however, since these units do not cancel each other out it is not clear how applicant is defining a value of distortion in terms of millimeters. The examiner attempting to use the values from the Tables, such as in Table 2 in order to try and determine applicant's intended meaning but was unable to do so. Specifically, the Tables (such as Table 2) do not set forth the values for " $A_L$ ". The term " $A_L$ " is defined in the specification as the "lens area" (page 4 of the specification) Even assuming that " $A_L$ " is the stated "distortion area" of Table 2, and that " $C_L$ " is the "channel length" of Table 2, the examiner was not able to determine the values of " $D_L$ " from Table 2 consistent with the stated values of " $D_L$ ". It is therefore not known how the value of " $D_L$ " is determined. For all of the aforementioned reasons, claim 1 (as well as dependent claims 2-5) lack enablement.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make

and/or use the invention. That part of the claim stating, "is less than about 0.125 diopters, than the sum of an absolute..." is not explained within the claim or the specification in a manner to render the claim enabling. It is not clear if applicant is claiming "is less than about 0.125 diopters over the value of the sum of an absolute..." or if some other meaning is intended and the lack of explanation creates the lack of enablement.

Claim 1 (and dependent claims 2-5) is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, applicant has not defined what is meant by the term "normalized lens distortion" within the claim rendering the claim vague and indefinite. On page 4 of the specification, fourth paragraph, applicant states that "normalized lens distortion is the integrated, unwanted astigmatism of the lens..." and then further states that it "can be calculated by the equation...". It is assumed that claim 1 is defining "normalized lens distortion" as that which is determined from equation "I" and equation "II" and it is suggested that applicant insert both equations "I" and "II" within the body of claim 1 (such as by stating within claim 1, "wherein normalized lens distortion is determined from the following equation... and wherein  $A_1$  is determined from the following equation...") to provide the required clarity.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(d) as being barred by applicant's patent in Japan document no. 2000-24992 (hereinafter referred to as "Japanese'992").

Japanese'992 reads on these claims by disclosing the limitations therein including the following: the claimed progressive addition lenses (English abstract); one surface that is a combined progressive and regressive surface (English abstract); that an additional surface can be either progressive or regressive (see entire document); the composite surface maximum local unwanted astigmatism as claimed (see examples and entire document, i.e. to the extent this limitation is understood). The progressive lens of Japanese'992 would inherently have a normalized lens distortion as claimed (to the extent this limitation is understood), this being reasonably based upon the similarity in structure to that of the claimed invention as well as upon the large value (less than about 300) claimed.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Roddy.

Roddy reads on this claim by disclosing a progressive addition lens (abstract) having virtually zero distortion in the near zone, intermediate zones and in the peripheral portions of the lens (column 3, line 59 to column 4, line 25, column 6, lines 12-31, column 7, lines 4-18). The progressive addition lenses of Roddy will inherently have a normalized lens distortion (as this term is understood) below the value as

claimed, this being reasonably based upon Roddy disclosing the lens as a low distortion lens, particularly in the near zone, intermediate zones and in the peripheral portions.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ueno et al.

Ueno et al reads on this claim by disclosing a progressive addition lens (column 1, lines 18-34) The progressive addition lenses of Ueno et al will inherently have a normalized lens distortion (as this term is understood) below the value as claimed, this being reasonably based upon Ueno et al as disclosing the lens as having minimal distortion (column 6, line 66 to column 7, line 35 and column 10, lines 39-48).

### ***Prior Art Citations***

European document no. EP-1-026-533 is being cited herein to show a progressive lens that would have read on claims 1-5, similar to Japanese'992, however, such rejections would have been repetitive. Furthermore, claims 2-5 could have been rejected based upon Ueno in view of either Japanese'992 or European document no. EP-1-026-533, however, such rejections would have been repetitive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (703) 308-1286. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

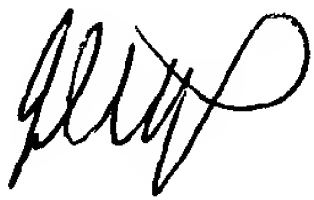
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308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
February 26, 2003